REMARKS

Claims 1-18 are pending in the present application. In the Office Action, the Examiner objected to claims 1, 6, 10, and 14 because of the alleged informality, "the second subspaces." Applicants respectfully submit that claims 1, 6, 10, and 14 set forth "at least two subspaces." Thus, the present invention is not limited to a single "second subspace." Applicants submit that the phrase "second subspaces" is correct and request that the Examiner's objections to claims 1, 6, 10, and 14 be withdrawn.

In the Office Action, the Examiner rejected claims 3, 7, 11, and 16 under 35 USC 112, first paragraph, is failing to comply with the enablement requirement. The Examiner also rejected claims 1-18 under 35 USC 112, second paragraph, as being indefinite. In these rejections, the Examiner alleged that the phrase "using a second code in one subspace" was not enabling or clear. The Examiner also alleged that the phrase "different subspace" was not clear. Applicants respectfully disagree and note that the phrases "one subspace" and "different subspace" are intended to encompass various embodiments of the present invention. In one embodiment, the "one subspace" is a first subspace and the "different subspace" is one of the second subspaces. In other embodiments, the "one subspace" is one of the second subspaces and the "different subspace" is the first subspace or another one of the second subspaces. Thus, Applicants believe that the present claims are clear and enabled by the specification. However, in the interest of clarity, Applicants have amended claims 1-2, 6, 10, and 14-15 to set forth "one of the at least two subspaces" and "a different one of the at least two subspaces." No new matter has been introduced by the aforementioned amendments. The claims have in no way been narrowed by virtue of these amendments and so these amendments should not be interpreted as

narrowing the claimed invention for purposes of any determination under the doctrine of equivalents.

In the Office Action, the Examiner rejected claims 1 and 14 under 35 U.S.C. 103(a) as being unpatentable over Bodin, et al (U.S. Patent No. 5,301,356) in view of Schilling (U.S. Patent No. 5,410,568). Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bodin in view of Schilling and further in view of Gilhousen (WO 95/03652). Claims 6 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bodin in view of Schilling and further in view of Gilhousen. Claims 4-5, 12-13, and 17-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bodin in view of Schilling and Gilhousen and further in view of Arai (U.S. Patent No. 5,907,545) The Examiner's rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).). There must also be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). Applicants respectfully submit that the cited references do not teach or suggest all the claim limitations. The cited references also fail to provide any suggestion or motivation to modify the prior art to arrive at Applicants' claimed invention.

Bodin describes a control procedure for locating neighboring base stations for handoff, *i.e.* Bodin describes a control procedure for a handoff between a first base station and a target base station. Once a target base station has been identified, a central processing unit 200 polls all general channels corresponding to the target base station to determine if there is an available general channel. If no general channels are available, the central processing unit 200 polls reserved channels associated with the target base station to determine if there is an available reserved channel. The available channel, either a general channel or a reserved channel, is then assigned to a handoff request. See Bodin, Figure 6 and related discussion.

The Examiner equates the general and reserved channels described by Bodin with the first and second codes set forth in the present invention. The Examiner then alleges that Bodin describes assigning a first code to a user currently using a second code in one of the at least two subspaces (*i.e.*, the general channel subspace and the reserved channel subspace) and performing an in-sector handoff of the user from the second code to the first code. Applicants respectfully disagree. As discussed above, Bodin teaches that either a general channel (if available) or a reserve channel (if available) may be assigned to a handoff request so that a user may be handed off to a target base station. Assuming *arguendo* that the Examiner's assumption that the general and the reserved channels of Bodin are the same as the first and second codes of Applicants' invention (and they are not), Bodin still does not teach that a user currently using either a general channel or a reserved channel may be assigned to a channel in the other subspace. For example, Bodin does not teach that a user currently using a general channel may then be assigned to a reserved channel.

Moreover, as admitted by the Examiner in lines 2-3 on page 5 of the Office Action, Bodin does not teach or suggest performing an in-sector handoff, as set forth in independent

claims 1, 6, 10, and 14. The Examiner attempts to remedy this admitted deficiency of the primary reference by stating that the same principles apply to the handoff between sectors described by Bodin and to the in-sector handoff set forth in the present invention. Applicants respectfully submit that whether or not the same principles apply is not material to a determination of obviousness because Bodin admittedly fails to teach or suggest performing an in-sector handoff.

The Examiner relies upon the secondary references, Gilhousen, Shilling, and Arai to teach assigning a second code to a different subspace, assigning codes on a time shared basis, and a second subspace used for data communication, respectively. However, none of the secondary references remedy the fundamental deficiencies of the primary reference, *i.e.* the failure to teach or suggest assigning a first code to a user currently using a second code in one of the at least two subspaces and the failure to teach or suggest performing an in-sector handoff of the user from the second code to the first code.

Applicants also submit that the cited references fail to provide any suggestion or motivation to modify the references or to combine reference teachings to arrive at Applicants' claimed invention. As discussed above, Bodin is concerned with a control procedure for a handoff between a first base station and a target base station and thus is completely silent with regard to performing any sort of in-sector handoff. The secondary references are also completely silent with regard to performing an in-sector handoff.

For at least the aforementioned reasons, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case that the present invention is obvious in view of the cited references, either alone or in combination. Thus, Applicants request that the Examiner's rejections of claims 1-2, 4-6, 10, 12-15, and 17-18 under 35 U.S.C. 103(a) be withdrawn.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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